

Sonnenschein

SONNENSCHN NATH & ROSENTHAL LLP

1530 Page Mill Road, Suite 200
Palo Alto, California 94304
650-798-0300
650-798-0310 fax
www.sonnenschein.com

Facsimile Transmittal Sheet

DATE 04/07/2010

PLEASE DELIVER THE FOLLOWING PAGES TO

NAME Huber, Nathan C.
FIRM USPTO
PHONE (571) 270-3923
FAX (571) 273-3923
CLIENT / MATTER Confidential
FROM Stephen M De Klerk DIRECT DIAL 650-798-0342
TOTAL NUMBER OF PAGES TRANSMITTED, INCLUDING THIS SHEET 28

MESSAGE

Examiner Huber.

Attached herewith is the Applicant Initiated Interview Request Form with a copy of a DRAFT Preliminary Amendment with RCE for your review, per your discussion with Mr. De Klerk.

Thank you,

Ariana Bates
Secretary to Stephen M De Klerk

Email: sdeklerk@sonnenschein.com

Original will NOT be mailed

CONFIDENTIALITY NOTE

The documents accompanying this facsimile transmission and the Facsimile Transmission Sheet contain information from the law firm of Sonnenschein Nath & Rosenthal LLP which is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution or use of the contents of this facsimile information is prohibited. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.

IF YOU DO NOT RECEIVE ALL OF THE PAGES ABOVE, PLEASE CALL 312 876 8101 AS SOON AS POSSIBLE

SONNENSCHN FACSIMILE DEPARTMENT USE ONLY

TRANSMISSION COMPLETED AT

DOCUMENT TRANSMITTED BY

Brussels Chicago Dallas Kansas City Los Angeles New York Phoenix St. Louis
San Francisco Short Hills, N.J. Silicon Valley Washington, D.C. West Palm Beach

Doc Code: M865 or FAIREQINTV

PTOL-413A (10-09)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE**Applicant Initiated Interview Request Form**

Application No. 10/797464 First Named Applicant: Russell Allen Foltz-Smith
 Examiner: Uber, Nathan C Art Unit: 3622 Status of Application: Pending

Tentative Participants:

(1) Nathan C. Uber (2) Eric Stamber
 (3) Stephen M. De Klerk (4) _____

Proposed Date of Interview: April 20, 2010 Proposed Time: 1PM EST (AM/PM)

Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☐ NO

If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Nor Agreed
(1) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Continuation Sheet Attached

☐ Proposed Amendment or Arguments Attached

Brief Description of Arguments to be Presented:

Please see attached DRAFT Preliminary Amendment.

An interview was conducted on the above-identified application on _____.

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

/Stephen M. De Klerk/
 Applicant/Applicant's Representative Signature _____ Examiner/SPE Signature _____

Stephen M. De Klerk
 Typed/Printed Name of Applicant or Representative

46,503
 Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

~ DRAFT ~

Attorney's Docket No.: 30000060-0003-002

Parent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)	
)	
Russell Alan Foltz-Smith)	Examiner: Nathan C. Uber
)	
Application No: 10/797,464)	Art Unit: 3622
)	
Filed: March 10, 2004)	Confirmation No: 4539
)	
For: SYSTEM FOR ORGANIZING)	
ADVERTISEMENTS ON A WEB PAGE)	
AND RELATED METHOD)	
)	

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRELIMINARY AMENDMENT WITH
REQUEST FOR CONTINUED EXAMINATION (RCE)

Dear Sir:

In response to the Final Office Action dated August 18, 2009, Applicant respectfully requests that the above-identified application be amended as follows and that the following remarks be considered:

Serial No: 10/797,464
Inventors: Russell Alan Foltz-Smith, et al.

- 1 -

Examiner: Nathan C. Uber
Art Unit: 3622

~ DRAFT ~

IN THE CLAIMS

Please amend the following claims which are pending in the present application:

1. (Withdrawn) A system comprising:

a search engine server having a first computer-readable medium containing information for a search provider's web page;

an advertiser server coupled to the search engine server and having a second computer-readable medium containing information for an advertiser's web page;

and

a user computer coupled to the search engine server and the advertiser's server, the

user computer having a monitor that is configured to display web pages;

wherein the search provider's web page, when displayed on the monitor, includes ads with each ad including a link to an advertiser's web page, where an advertiser is an entity whose ad is displayed on the search provider's web page, and a position of each ad on the search provider's web page is dependent upon whether the search provider is due payment from the advertiser.

2. (Withdrawn) The system according to claim 1, wherein the position of the ad on the search provider's web page is dependent upon whether a link included in an ad has received a predetermined number of clicks within a predetermined period of time.

~ DRAFT ~

3. (Withdrawn) The system according to claim 1, wherein;

a sponsor is an advertiser that has a financial agreement with the search provider regarding the inclusion of the sponsor's ad on the search provider's web page;

a non-sponsor is an advertiser whose ad is displayed on the search provider's web page free of charge; and

non-sponsors' ads are displayed in a region of the search provider's web page below another region of the search provider's web page where sponsors' ads are displayed.

4. (Withdrawn) The system according to claim 3, wherein the search provider is due a fee from a sponsor every time a user selects a link associated with the sponsor's ad displayed on the search provider's web page.

5. (Withdrawn) The system according to claim 3, wherein the sponsor's ad has associated with it a cap amount that is the maximum amount of money that a sponsor can be billed by the search provider for the sponsor's ad within a billing cycle.

6. (Withdrawn) The system according to claim 5, wherein a location where the sponsor's ad is displayed on the search provider's web page is influenced by a difference between the cap amount and a total accrued debt owed by the sponsor to the search provider for the sponsor's ad.

~ DRAFT ~

7. (Withdrawn) The system according to claim 6, wherein the sponsor's ad is located within the region of the search provider's web page with non-sponsors' ads when the total accrued debt owed by the sponsor to the search provider for the sponsor's ad equals the cap amount.

8. (Withdrawn) The system according to claim 5, wherein the sponsor can change the cap amount.

9. (Withdrawn) A first computer-readable medium included in a search engine server, wherein the first computer-readable medium contains a program configured to interact with a database stored in a second computer-readable medium also included in the search engine server, wherein the search engine server is configured to couple to an advertiser server having a third computer-readable medium containing information for an advertiser's web page, and wherein the search engine server is configured to couple to a user computer having a monitor that is configured to display a web page, the program comprising information used to generate a search provider's web page, wherein:

the search provider's web page is displayed on the monitor and includes ads that are stored in the database, with each ad including a link to an advertiser's web page, where an advertiser is an entity whose ad is displayed on the search provider's web

~ DRAFT ~

page, and a sponsor is an advertiser that has a financial agreement with the search provider regarding the inclusion of the sponsor's ad on the search provider's web page;

the search provider is due a fee from the sponsor every time a user selects a link included in the sponsor's ad displayed on the search provider's web page;

the sponsor's ad has associated with it a cap amount that is the maximum amount of money that a sponsor can be billed by the search provider for the sponsor's ad within a billing cycle; and

a location where the sponsor's ad is displayed on the search provider's web page is influenced by a difference between the cap amount and a total accrued debt owed by the sponsor to the search provider for the sponsor's ad.

10. (Withdrawn) The program according to claim 9, wherein:

a non-sponsor is an advertiser whose ad is displayed on the search provider's web page free of charge; and

non-sponsors' ads are displayed in a region of the search provider's web page below another region of the search provider's web page where sponsors' ads are displayed.

11. (Withdrawn) The program according to claim 10, wherein the sponsor's ad is located within a region of the search provider's web page with non-sponsors' ads when the total accrued debt owed by the sponsor to the search provider for the sponsor's ad equals the cap amount.

~ DRAFT ~

12. (Withdrawn) The program according to claim 9, wherein the sponsor can change the cap amount.

13. (Withdrawn) A method for organizing ads on a search provider's web page, wherein information related to the search provider's web page is stored in a first computer-readable medium included in a search engine server, wherein the information related to the search provider's web page is configured to interact with advertiser information in an advertiser database stored in a second computer-readable medium that also is included in the search engine server, wherein an advertiser is an entity having an ad that is displayed on the search provider's web page, wherein the search engine server is configured to couple to an advertiser server having a third computer-readable medium containing information for an advertiser's web page, wherein the search engine server is configured to couple to a user computer having a monitor that is configured to display a web page, and wherein each sponsor's ad has associated with it a cap amount that is the maximum amount of money that a sponsor can be billed by the search provider for the sponsor's ad within a billing cycle, the method comprising:

performing a category search using the search engine server for ads included in the advertiser database;

creating a list of sponsors' ads based on results of the category search; and

~ DRAFT ~

positioning the sponsors' ads on the search provider's web page based on a difference between the cap amount and a total accrued debt owed by the sponsor to the search provider for the sponsor's ad.

14. (Withdrawn) The method according to claim 13, further comprising:
calculating a geographic region of consideration; and
removing all sponsor ads from the list of sponsors' ads when the respective sponsor's business location is outside of the geographic region of consideration.

15. (Withdrawn) The method according to claim 14, wherein the geographic region of consideration is a circle having a center point and a radius, and the radius is multiplied by a market multiplier factor that varies as a function of a location of the center point.

16. (Withdrawn) The method according to claim 14, further comprising:
calculating a pacing factor; and

comparing a random number, having a value between zero and one, to the pacing factor for each sponsor's ad and displaying the sponsor's ad on the search provider's web page only if the pacing factor is greater than the random number.

~ DRAFT ~

17. (Withdrawn) The method according to claim 16, further comprising sorting the sponsors' ads and displaying the sponsors' ads on the search provider's web page according to the cost-per-click multiplied by the click-through rate associated with each sponsor's ad.

18. (Withdrawn) The method according to claim 16, further comprising:
calculating a sorting factor; and
sorting the sponsors' ads and displaying the sponsors' ads on the search provider's web page according to the sorting factor.

19. (Withdrawn) The method according to claim 13, wherein a non-sponsor is an advertiser whose ad is displayed on the search provider's web page free of charge.

20. (Withdrawn) The method according to claim 19, further comprising displaying non-sponsors' ads in a region of the search provider's web page below another region of the search provider's web page where sponsors' ads are displayed.

21. (Withdrawn) The method according to claim 20, further comprising positioning the sponsor's ad within a region of the search provider's web page with non-sponsors' ads when the total accrued debt owed by the sponsor to the search provider for the sponsor's ad equals the cap amount.

~ DRAFT ~

22. (Currently Amended) A computer system comprising:

- at least one processor;
- a medium connected to the processor; and
- a set of software on the medium and being at least readable by the processor, the set of ~~[[data]]~~software including:
 - advertiser payment information;
 - a query receiving function executable by the processor to receive a search query over a network from a user computer system;
 - geographic data of a location;
 - a mapping function executable by the processor to map the query to at least one mapped query sales category among a plurality of query sales categories;
 - an advertiser data store including a plurality of advertiser entries each being associated with a respective data store sales category;
 - a search engine executable by the processor to ~~automatically in response to the mapping to the sales category~~ extract a plurality of search results from the advertiser entries based on ~~the sales category and the geographic location data and by associating the mapped sales query category with one of the data store sales categories~~;
 - a ranking function executable by the processor to rank the search results based on at least the advertiser payment information into a ranked set of search results; and
 - a transmission function executable by the processor to transmit the set of ranked search results over a network to the user computer system, each one of the

~ DRAFT ~

ranked search results including a link to retrieve a respective advertiser web page over a network from a respective advertiser computer system utilizing the user computer system.

23. (Previously Presented) The computer system of claim 22 wherein the ranking is dependent upon whether a link included in an ad has received a predetermined number of clicks within a predetermined period of time.

24. (Previously Presented) The computer system of claim 22 wherein a sponsor is an advertiser that has a financial agreement with the search provider regarding the inclusion of the sponsor's ad on the search provider's web page, a non-sponsor is an advertiser whose ad is displayed on the search provider's web page free of charge; and non-sponsors' ads are displayed in a region of the search provider's web page below another region of the search provider's web page where sponsors' ads are displayed.

25. (Previously Presented) The computer system of claim 24 wherein the search provider is due a fee from a sponsor every time a user selects a link associated with the sponsor's ad displayed on the search provider's web page.

26. (Previously Presented) The computer system of claim 25 wherein the sponsor's ad has associated with it a cap amount that is the maximum amount of money that a sponsor can be billed by the search provider for the sponsor's ad within a billing cycle.

~ DRAFT ~

27. (Previously Presented) The computer system of claim 26 wherein a location where the sponsor's ad is displayed on the search provider's web page is influenced by a difference between the cap amount and a total accrued debt owed by the sponsor to the search provider for the sponsor's ad.

28. (Previously Presented) The computer system of claim 27 wherein the sponsor's ad is located within the region of the search provider's web page with non-sponsors' ads when the total accrued debt owed by the sponsor to the search provider for the sponsor's ad equals the cap amount.

29. (Previously Presented) The computer system of claim 27 wherein the sponsor can change the cap amount.

30. (Cancelled)

31. (Previously Presented) The computer system of claim 22, the set of software further comprising: a geo-location function that determines a location of the user computer system.

32. (Previously Presented) The computer system of claim 31, the set of software further comprising: a geo-location function calculating a geographic region of

~ DRAFT ~

consideration, and removing all sponsor ads from the list of sponsors' ads when the respective sponsor's business location is outside of the geographic region of consideration.

33. (Previously Presented) The computer system of claim 32 wherein the geographic region of consideration is a circle having a center point and a radius, and the radius is multiplied by a market multiplier factor that varies as a function of a location of the center point.

34. (Currently Amended) A computer-based method comprising:
 storing advertiser information on at least one computer-readable medium;
 storing geographic data of a location on the medium;
 storing a plurality of advertiser entries in a data store on the medium each advertiser entry being associated with a respective data store sales category;
storing a search engine on the medium;
 receiving a search query over a network from a user computer system at a server computer system;
~~mapping~~utilizing the processor of the server computer system to map the query to at least one mapped query sales category among a plurality of query sales categories ~~utilizing a processor of the server computer system~~;
~~operating~~utilizing the processor to operate the search engine to ~~automatically in response to the mapping to the sales category~~ extract a plurality of search

~ DRAFT ~

result from the advertiser entries based on ~~the sales category and~~ the geographic location data ~~utilizing the processor and by associating the mapped query sales category with one of the data store sales categories;~~

~~ranking~~utilizing the processor to rank the search results based on at least the advertiser payment information into a ranked set of search results ~~utilizing the processor;~~ and

~~transmitting~~utilizing the processor to transmit the set of ranked search results from the server computer system over a network to the user computer system, each one of the ranked search results including a link to retrieve a respective advertiser web page over a network from a respective advertiser computer system ~~utilizing the user computer system.~~

35. (Previously Presented) The computer-based method of claim 34 wherein the ranking is dependent upon whether a link included in an ad has received a predetermined number of clicks within a predetermined period of time.

36. (Previously Presented) The computer-based method of claim 34 further comprising: displaying non-sponsors' ads in a region of the search provider's web page below another region of the search provider's web page where sponsors' ads are displayed.

~ DRAFT ~

37. (Previously Presented) The computer-based method of claim 36 wherein the search provider is due a fee from a sponsor every time a user selects a link associated with the sponsor's ad displayed on the search provider's web page.

38. (Previously Presented) The computer-based method of claim 37 wherein the sponsor's ad has associated with it a cap amount that is the maximum amount of money that a sponsor can be billed by the search provider for the sponsor's ad within a billing cycle.

39. (Previously Presented) The computer-based method of claim 38 wherein a location where the sponsor's ad is displayed on the search provider's web page is influenced by a difference between the cap amount and a total accrued debt owed by the sponsor to the search provider for the sponsor's ad.

40. (Previously Presented) The computer-based method of claim 39 wherein the sponsor's ad is located within the region of the search provider's web page with non-sponsors' ads when the total accrued debt owed by the sponsor to the search provider for the sponsor's ad equals the cap amount.

41. (Previously Presented) The computer-based method of claim 39 wherein the sponsor can change the cap amount.

~ DRAFT ~

42. (Cancelled)

43. (Previously Presented) The computer-based method of claim 34 further comprising:

calculating a pacing factor; and

comparing a random number, having a value between zero and one, to the pacing factor for each sponsor's ad and displaying the sponsor's ad on the search provider's web page only if the pacing factor is greater than the random number.

44. (Previously Presented) The computer-based method of claim 43 further comprising sorting the sponsors' ads and displaying the sponsors' ads on the search provider's web page according to the cost-per-click multiplied by the click-through rate associated with each sponsor's ad.

45. (Previously Presented) The computer-based method of claim 44 further comprising:

calculating a sorting factor; and

sorting the sponsors' ads and displaying the sponsors' ads on the search provider's web page according to the sorting factor.

~ DRAFT ~

46. (Previously Presented) The computer-based method of claim 34 further comprising: determining a location of the user computer system utilizing a geo-location function.

47. (Previously Presented) The computer-based method of claim 46 further comprising: a geo-location module calculating a geographic region of consideration, and removing all sponsor ads from the list of sponsors' ads when the respective sponsor's business location is outside of the geographic region of consideration.

48. (Previously Presented) The computer-based method of claim 47 wherein the geographic region of consideration is a circle having a center point and a radius, and the radius is multiplied by a market multiplier factor that varies as a function of a location of the center point.

49. (Currently Amended) A computer-readable medium having stored thereon a set of data that is executable by a processor of a computer to execute a method comprising:

storing advertiser information on a medium;

storing geographic data of a location on the medium;

storing a plurality of advertiser entries in a data store on the medium each advertiser entry being associated with a respective data store sales category;

storing a search engine on the medium;

~ DRAFT ~

receiving a search query over a network from a user computer system;
~~mapping utilizing the processor of the server computer system to map the~~
query to at least one mapped query sales category among a plurality of query sales
categories;
~~operating utilizing the processor to operate the search engine to~~
~~automatically in response to the mapping to the sales category~~ extract a plurality of search
result from the advertiser entries based on ~~the sales category and~~ the geographic location
data and by associating the mapped query sales category with one of the data store sales
categories;
~~ranking utilizing the processor to rank~~ the search results based on at least
the advertiser payment information into a ranked set of search results; and
~~transmitting utilizing the processor to transmit~~ the set of ranked search
results from the server computer system over a network to the user computer system, each
one of the ranked search results including a link to retrieve a respective advertiser web
page over a network from a respective advertiser computer system.

50. (Previously Presented) The computer-readable medium of claim 49
wherein the ranking is dependent upon whether a link included in an ad has received a
predetermined number of clicks within a predetermined period of time.

51. (Previously Presented) The computer-readable medium of claim 49
further comprising: displaying non-sponsors' ads in a region of the search provider's web

~ DRAFT ~

page below another region of the search provider's web page where sponsors' ads are displayed.

52. (Previously Presented) The computer-readable medium of claim 51 wherein the search provider is due a fee from a sponsor every time a user selects a link associated with the sponsor's ad displayed on the search provider's web page.

53. (Previously Presented) The computer-readable medium of claim 52 wherein the sponsor's ad has associated with it a cap amount that is the maximum amount of money that a sponsor can be billed by the search provider for the sponsor's ad within a billing cycle.

54. (Previously Presented) The computer-readable medium of claim 53 wherein a location where the sponsor's ad is displayed on the search provider's web page is influenced by a difference between the cap amount and a total accrued debt owed by the sponsor to the search provider for the sponsor's ad.

55. (Previously Presented) The computer-readable medium of claim 54 wherein the sponsor's ad is located within the region of the search provider's web page with non-sponsors' ads when the total accrued debt owed by the sponsor to the search provider for the sponsor's ad equals the cap amount.

~ DRAFT ~

56. (Previously Presented) The computer-readable medium of claim 54 wherein the sponsor can change the cap amount.
57. (Cancelled)
58. (Currently Amended) The computer-readable medium of claim 49 further comprising:
- calculating a pacing factor; and
 - comparing a random number, having a value between zero and one, to the pacing factor for each sponsor's ad and displaying the sponsor's ad on the search provider's web page only [[5]] if the pacing factor is greater than the random number.
59. (Previously Presented) The computer-readable medium of claim 58 further comprising sorting the sponsors' ads and displaying the sponsors' ads on the search provider's web page according to the cost-per-click multiplied by the click-through rate associated with each sponsor's ad.
60. (Previously Presented) The computer-readable medium of claim 59 further comprising:
- calculating a sorting factor; and
 - sorting the sponsors' ads and displaying the sponsors' ads on the search provider's web page according to the sorting factor.

~ DRAFT ~

61. (Previously Presented) The computer-readable medium of claim 49, the data further comprising: a geo-location function that determines a location of the user computer system.

62. (Previously Presented) The computer-readable medium of claim 61 further comprising: a geo-location module calculating a geographic region of consideration, and removing all sponsor ads from the list of sponsors' ads when the respective sponsor's business location is outside of the geographic region of consideration.

63. (Previously Presented) The computer-readable medium of claim 62 wherein the geographic region of consideration is a circle having a center point and a radius, and the radius is multiplied by a market multiplier factor that varies as a function of a location of the center point.

64. (Previously Presented) The system of claim 26 wherein the set of data further includes a pacing function that calculates a billing frequency based on the cap amount and a future date or time.

~ DRAFT ~

65. (Previously Presented) The computer-based method of claim 38, further comprising executing a pacing function that calculates a billing frequency based on the cap amount and a future date or time.

66. (Previously Presented) The computer-readable medium of claim 53, the method further comprising executing a pacing function that calculates a billing frequency based on the cap amount and a future date or time.

~ DRAFT ~

REMARKS

Applicant respectfully requests reconsideration of the subject application. This Response is submitted in response to the Final Office Action mailed January 21, 2010. Claims 1-29, 31-41, 43-56 and 58-66 are pending. Claims 1-21 are withdrawn from consideration. Claims 22-29, 31-41, 43-56 and 58-66 are rejected. In this Amendment, claims 22, 34, 49 and 58 have been amended. No new matter has been added.

35 U.S.C. § 112 Rejections

The Examiner has rejected claim 22 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states that claim 22 includes both data and software. Applicant has amended claim 22 so that only software is claimed. Applicant believes that the amendment overcomes the Examiner's rejection. Applicant, respectfully requests withdrawal of the rejections of claim 22 under 35 U.S.C. § 112, second paragraph.

The Examiner also made the suggestion that the data (such as the advertisement payment information) can be claimed separately from functions that are executed by the processor. Applicant understands that such a modification to the claim will allow for separation of executable and non-executable pieces of the technology. However, Applicant is concerned that such a modification could make the claim difficult to comprehend under this section because of separation of the computer-readable

~ DRAFT ~

instructions. Applicant submits that the invention as claimed would be relatively easily ascertainable by one of ordinary skill in the art.

35 U.S.C. § 101 Rejections

The Examiner has rejected claim 34 under 35 U.S.C. § 101 because the invention is directed to non-statutory subject matter. On page 3, lines 9-11, the Examiner states that the limitation "operating a search engine" does not satisfy the requirement under 35 U.S.C. § 101 because a human operator may complete this step and satisfy this claim, and human operators are not statutory classes of invention. Claim 34 has been amended by reciting "utilizing the processor to operate the search engine." Claim 34 has also been amended to recited that a search engine is stored on the medium. Furthermore, the processor forms part of a server computer system. The processor, search engine, server computer system and medium are all non-human. As such, Applicant respectfully submits that claim 34 now satisfies the requirement under 35 U.S.C. § 101, and Applicant respectfully requests withdrawal of the rejections thereof.

In paragraph 9, pages 3-4 of the Office Action, the Examiner has discussed the non-patentability of extra-solution activity. This discussion relates to the same limitation referred to by the Examiner on page 3, lines 9-11. By amending the claim as indicated, human operators are eliminated from the claim and hence there can be no extra-solution activity not carried out by a particular machine.

Serial No: 10/797,464
Inventors: Russell Alan Foltz-Smith, et al.

- 23 -

Examiner: Nathan C. Uber
Art Unit: 3622

~ DRAFT ~

35 U.S.C. §103 Rejections

The Examiner has rejected claims 22-29, 31-41, 43-56 and 58-66 under 35 U.S.C. § 103(a) as being unpatentable over Cheung, et al., (U.S Patent Publication No.: 2003/0028529, hereinafter "Cheung") in view of Leishman, et al., (U.S Patent Publication No.: 2004/0073538, hereinafter "Leishman"). Applicant submits that the claims, as amended, are patentable over the combination of references.

On pages 5 and 6 the Examiner states that Cheung discloses all the elements of the claim except for geographic data of a location, and on page 6 the Examiner states that Leishman discloses geographic data of a location. At the bottom of page 5 and the top of page 6 the Examiner states that databases inherently include the functionality of ranking and categorizing/"mapping to a category". However, according to the present invention, there not only exists a plurality of data store sales categories, but there is also a mapping function that maps the query to a mapped query sales category. The mapped query sales category can then be associated with one of the data store sales categories. The associated data sales category and the geographic location data are then used to extract search results.

Claim 22 now specifically includes the limitations of:

*...a mapping function executable by the processor to map the query to at least one mapped query sales category among a plurality of query sales categories;
an advertiser data store including a plurality of advertiser entries
each being associated with a respective data store sales category;

~ DRAFT ~

a search engine executable by the processor to extract a plurality of search results from the advertiser entries based on the geographic location data and by associating the mapped sales query with one of the data store sales categories;..."

Applicant submits that Cheung does not disclose the invention as claimed. Cheung only discloses a structured data base. Cheung does not also include a mapping function to map a query sales category among a plurality of query sales categories. Furthermore, Cheung does not disclose the limitation of utilizing the mapped query sales category to associate a data store sales category from the data store.

Leishman adds nothing to Cheung in this regard and has been relied on by the Examiner for disclosing geographic data of a location.

The combination of references fails to teach or suggest a number of limitations of claim 22. As such, Applicant submits that claim 22 is patentable over the combination of references. Claims 23-29 and 31-33 depend from claim 22 and should be allowable for at least the same reasons as claim 22. Claim 34 has been amended with limitations similar to the limitations that have been added to claim 22 and should thus be allowable for at least the same reasons as claim 22. Claims 35-48 depend from claim 34 and should be allowable for at least same reasons as claim 34. Claim 49 is similar to claim 34 and claims 50-56 and 58-66 depend from claim 49.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 22-29, 31-41, 43-56 and 58-66 under 35 U.S.C. § 103(a) as being unpatentable over Cheung in view of Leishman.

~ DRAFT ~

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Stephen M. De Klerk at (650) 798-0342.

Please charge any shortages and credit any overages to Deposit Account No. 19-3140. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 19-3140.

Respectfully submitted,
SONNENSCHN NATH & ROSENTHAL LLP

Date: April 7, 2010

/Stephen M. De Klerk/

Stephen M. De Klerk
Reg. No. 46,503

P.O. Box 061080
Wacker Drive Station, Willis Tower
Chicago, Illinois 60606-1080
650-798-0342